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Attorney Docket No. P70650US0

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Knut ADERMANN et al.

Application No. 10/539,627

Patent No. 7655629

Filed: September 19, 2005

Issue Date: February 2, 2010

For PEPTIDES AND THEIR USE FOR THE TREATMENT OF HIV INFECTIONS

REQUEST FOR
RECONSIDERATION OF INCORRECT *WYETH* PATENT TERM ADJUSTMENT
RECALCULATION [35 USC(b)(3)(B)(ii)]
AND
REFUND OF FEE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The decision on the request for recalculation of patent term adjustment in view of *Wyeth*, mailed May 13, 2010, incorrectly recalculated the patent term adjustment "to 450 days," as explained in detail below. Submitted herewith are the requisite \$200 fee, Patent Term Adjustment History obtained online from the PTO Private PAIR database (one page) for the "450" days PTA (as recalculated), and copy of Notice of Allowability of the subject patent application mailed December 21, 2008.

Specifically, the PTO erred in its determination of the time period under 37 CFR 1.703(b) at "301" days (the PTA "36 Months" entry in the attached patent term adjustment history), by using as the Rule 703(b)(4) time period—to be excluded from the 703(b) period of adjustment—the 291 days filing the Notice of Appeal, on November 17, 2008, and mailing of the Notice of Allowance, on September 4, 2009; whereas, the correct 703(b)(4) time period is only 35 days, *i.e.*, the number of days from filing the Notice of Appeal (November 17, 2008) to the mailing of the aforesaid Notice of Allowability—"an action under 35 U.S.C. 132"—on December 21, 2008, *i.e.*, on the attached patent term adjustment history, the Date of the "Examiner's Amendment Communication"—"attention being directed to the bottom, right of the Notice, which states: "Mail Date "20081221," and page 2 of the Notice, which contains "Examiner's Amendment."

06/08/2010 MBELETE2 00000149 7655629

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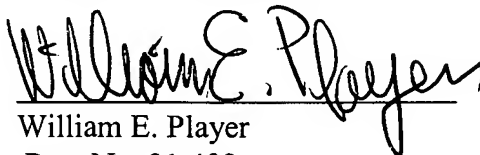
Attorney Docket No. P70650US0
Patent No. 7655629
Application No. 10/539,627

Thus, the recalculation excluded 256 days (291-35) more than should have been excluded—as the (b)(4) number of days. Adding back the excess 256 days (incorrectly excluded) effects 557 days (301+256) as the correct 703(b) period of adjustment and, correspondingly, the correct total PTA *Wyeth* recalculation of **706 days** (450+256), to which the subject patent is entitled.

Refund of the \$200 fee (submitted herewith) is requested in view of the foregoing explanation. In other words, the PTO offered, at no charge, to recalculate—under *Wyeth*—the originally accorded PTA, which patentees accepted, and so had a right to expect that the *Wyeth* recalculation would be done correctly, which it was not—moreover, it was not to the extent that the incorrect recalculation resulted in a PTA that was 50 days fewer than originally accorded. With all due respect, it is unjust, unfair, and inequitable to offer a recalculation free of charge, with the *proviso* that, should the recalculation be done incorrectly—especially to the extent of effecting 50 fewer days than originally accorded—it will cost the patentee \$200 to fix the PTO mistake.

For the foregoing reasons, grant of the correct PTA of 706 days and \$200 fee refund are in order.

Respectfully submitted,



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Date: June 7, 2010
WEP/mwb
Attachments (4 pages)

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10/539,627

PEPTIDES AND THEIR USE FOR THE TREATMENT OF HIV INFECTIONS

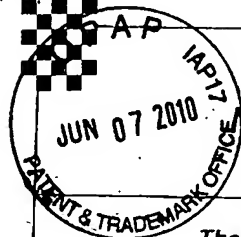
Select New Case	Application Data	Transaction History	Image File Wrapper	Patent Term Adjustments	Continuity Data	Foreign Priority	Fees	Published Documents	Address & Attorney/Agent	Supplemental Content	Assignments	Display Reference
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Patent Term Adjustment

Filing or 371(c) Date:	09-19-2005	USPTO Delay (PTO) Delay (days):	-
Issue Date of Patent:	02-02-2010	Three Years:	-
Pre-Issue Petitions (days):	-	Applicant Delay (APPL) Delay (days):	-
Post-Issue Petitions (days):	-	Total Patent Term Adjustment (days):	450
USPTO Adjustment (days):	-	Explanation Of Calculations:	?

Patent Term Adjustment History

Date	Contents Description	PTO(Days)	APPL(Days)
05-10-2010	Petition Decision - Granted		
05-04-2010	Petition Entered		
02-17-2010	Sequence Moved to Public Database		
02-02-2010	Recordation of Patent Grant Mailed		
01-13-2010	Issue Notification Mailed		
02-02-2010	PTA 36 Months	301	
02-02-2010	Patent Issue Date Used in PTA Calculation		
12-11-2009	Dispatch to FDC	↑	
12-10-2009	Application Is Considered Ready for Issue	↑	
12-02-2009	Issue Fee Payment Verified	↑	
12-02-2009	Issue Fee Payment Received	↑	
10-14-2009	Mail-Petition Decision - Dismissed	↑	
10-14-2009	Petition Decision - Dismissed	↑	
09-28-2009	Sequence Forwarded to Pubs on Tape	↑	
09-04-2009	Mail Notice of Allowance	121	
12-22-2008	Document Verification	↑	
12-22-2008	Notice of Allowance Data Verification Completed	↑	
12-19-2008	Examiner Interview Summary Record (PTOL - 413)	↑	
12-22-2008	Examiner's Amendment Communication	↑	
12-12-2008	Mail Advisory Action (PTOL - 303)	↑	
12-08-2008	Advisory Action (PTOL-303)	↑	
11-17-2008	Notice of Appeal Filed	↑	
11-17-2008	Request for Extension of Time - Granted	↑	
08-15-2008	Date Forwarded to Examiner	↑	
08-07-2008	Amendment after Final Rejection	↑	
05-16-2008	Mail Final Rejection (PTOL - 326)	14	
05-12-2008	Final Rejection	↑	
01-25-2008	Date Forwarded to Examiner	↑	
01-02-2008	Response after Non-Final Action		92
01-02-2008	Request for Extension of Time - Granted		↑
07-02-2007	Mail Non-Final Rejection		↑
06-25-2007	Non-Final Rejection		
11-01-2005	Information Disclosure Statement considered		
06-25-2007	Case Docketed to Examiner in GAU		
05-16-2007	Date Forwarded to Examiner		
05-07-2007	Response to Election / Restriction Filed		
05-07-2007	Request for Extension of Time - Granted		
03-29-2007	PG-Pub Issue Notification		
03-05-2007	Mail Restriction Requirement	106	
03-03-2007	Requirement for Restriction / Election	↑	
02-22-2007	Case Docketed to Examiner in GAU	↑	
01-27-2007	IFW TSS Processing by Tech Center Complete	↑	
11-01-2005	Information Disclosure Statement (IDS) Filed	↑	
11-01-2005	Information Disclosure Statement (IDS) Filed	↑	
09-19-2005	371 Completion Date	↑	
12-27-2006	Application Dispatched from OIPE		
02-23-2006	Additional Application Filing Fees		
02-23-2006	A set of symbols and procedures, provided to the PTO on a set of computer listings, that describe in		
02-23-2006	CRF Disk Has Been Received by Preexam / Group / PCT		
03-02-2006	Error(s) In CRF Corrected by STIC		
03-02-2006	CRF Is Good Technically / Entered into Database		
02-14-2006	Sequence disclosure problems		
12-18-2005	Cleared by OIPE CSR		
12-18-2005	Cleared by OIPE CSR		
12-18-2005	Cleared by OIPE CSR		
12-18-2005	Cleared by OIPE CSR		



Notice of Allowability

Application No.	Applicant(s)	
10/539,627	ADERMANN ET AL.	
Examiner	Art Unit	
MAURY AUDET	1654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to and now reversing the Advisory Action of 12/12/08, following amendment approval.
2. ☒ The allowed claim(s) is/are 29-34 and 37.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
 - * Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|--|
| <ol style="list-style-type: none"> 1. <input type="checkbox"/> Notice of References Cited (PTO-892) 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3. <input type="checkbox"/> Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____ 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | <ol style="list-style-type: none"> 5. <input type="checkbox"/> Notice of Informal Patent Application 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date <u>Attached</u>. 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment 8. <input type="checkbox"/> Examiner's Statement of Reasons for Allowance 9. <input type="checkbox"/> Other _____ |
|---|--|

/Cecilia Tsang/
Supervisory Patent Examiner, Art Unit 1654

Application/Control Number: 10/539,627
Art Unit: 1654

Page 2

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Bill Player, Applicant's Representative, on 12/19/08.

IN THE CLAIMS

In claim 1, line 1, the term "medicament" has been deleted and --composition-- inserted therein.

In claim 1, lines 2-4 and 5-6, the phrases "having biological activity against HIV infection" and ", a nucleic acid coding for the compound, or an antibody binding specifically to the compound" have been deleted, without prejudice.

New Claim 37 has been added:

37 (New): A nucleic acid, wherein said nucleic acid encodes the peptide of claim 29.

Conclusion

Claims 29-34 and 37 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MAURY AUDET whose telephone number is (571)272-0960. The examiner can normally be reached on M-Th. 7AM-5:30PM (10 Hrs.).

Application/Control Number: 10/539,627

Page 3

Art Unit: 1654

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecelia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MA, 12/21/2008

/Cecilia Tsang/

Supervisory Patent Examiner, Art Unit 1654